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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/183,717	10/30/1998	DAVID ALAN DESCH	080398.P162	3438

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EXAMINER

GRANT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 11/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/183,717

Applicant(s)
DESCH

Examiner
Christopher Grant

Art Unit
2611



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/13/02 and 8/28/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-48 and 53-66 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 53-66 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2611

DETAILED ACTION

1. Newly submitted claims 53-66 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 53-66 are directed to digital embodiments with the processing of "bit stream" as argued by applicant at page 16 of the amendment filed 5/13/02.

Furthermore, claims 58-61 are directed to a method of recording first and second bit streams.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 53-66 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2611

3. Claims 6-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauley and Schein et al. (Schein).

Considering claim 6, Pauley discloses an apparatus and corresponding method for selecting at least two shows capable of being received and displayed by an entertainment system comprising: selecting for viewing, a first show associated with a first channel; displaying the first show; selecting for viewing, a second show associated with a second channel; and displaying the second show.

However, Pauley fails to specifically disclose receiving first and second user-specified show selections, displaying first and second plural sources for the first and second show selections, receiving first and second source selections, receiving first and second signals, and displaying first and second show selections respectively as recited in the claims.

Schein discloses a multi-source information television system for easily selecting channels from a combined program schedule comprising the steps of:

- a1) receiving a first user show selection (col. 2, lines 44-46, col. 5, lines 39-45);
- b1) displaying a first plurality of sources for the first show selection (figure 3, col. 6, lines 8-16 and/or step 404, figure 4);
- c1) receiving a first source selection (col. 6, lines 39-52 and/or step 406, figure 4);
- d1) receiving a first signal identifying a selected source for the first user-specified show selection (col. 6, lines 39-52 and/or step 406, figure 4);
- e1) displaying first show selection (col. 6, lines 39-52 and/or step 406 figure 4) and

Art Unit: 2611

a2) receiving a second user show selection (.e.g. a second show such as Casablanca from figure 2 and the procedure is the same as step a);

b2) displaying a second plurality of sources for the first show selection (figure 3, col. 6, lines 8-16 and/or step 404, figure 4);

c2) receiving a second source selection (col. 6, lines 39-52 and/or step 406, figure 4);

d2) receiving a second signal identifying a selected source for the second user-specified show selection (col. 6, lines 39-52 and/or step 406, figure 4);

e2) displaying a second show selection (col. 6, lines 39-52 and/or step 406, figure 4).

Schein's display system allows the user to select one or more shows from multiple occurrences of the same shows from various input sources (e.g. DBS, Cable, regular broadcast etc.). The advantage is that the user can select a desired source at a desired time for a particular show.

It would have been obvious to one of ordinary skill in the art to modify Pauley's system to include receiving first and second user-specified show selections, displaying first and second plural sources for the first and second show selections, receiving first and second source selections, receiving first and second signals and displaying first and second show selections respectively, as taught by Schein, for the advantage of enabling easy selection of desired shows at desired times from a combined list of multiple input sources.

Art Unit: 2611

Claim 10 is met by the combined systems of Pauley and Schein, wherein Pauley discloses the various input sources in col. 5, lines 16-18 and Schein discloses the various input sources throughout the entire reference including but not limited to col. 2, lines 25-43.

Claim 12 is met by the combined systems of Pauley and Schein, wherein Schein discloses loading programming data associated with the selected first and/or second channels (see programming data in coordinator 14 in columns 3-4).

Claim 13 is met by the combined systems of Pauley and Schein, wherein Schein discloses that coordinator (13) includes CPU (26) and memory that serve as the devices for operating the system in col. 3, line 59 - col. 4, line 63.

Considering claims 7-9, the combined systems of Pauley and Schein disclose an apparatus for receiving programming from plural sources such as from a satellite system, local broadcast or cable companies. However, they fail to specifically disclose first and second coding techniques and that the first and second coding techniques are amplitude modulation, frequency modulation and phase modulation as recited in the claims.

The examiner takes Official Notice that it is notoriously well known in the art to implement amplitude modulation, frequency modulation and phase modulation for transmitting programs from a central station to terminals at user locations.

Art Unit: 2611

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combined systems of Pauley and Schein to include amplitude modulation, frequency modulation and phase modulation because these are well known transmission techniques used for broadcasting programs to viewers/subscribers.

Claim 11 is met by the combined systems of Pauley and Schein, wherein Pauley discloses various input sources in col. 5, lines 16-18 and Schein discloses various input sources in col. 2, lines 25-43.

Claims 14 and 15 are met by the combined systems of Pauley and Schein, wherein Schein discloses a VCR (13) for recording a first, second or any number of shows throughout the reference including but not limited to column 6, lines 39-52.

As for claims 16-17 and 26-27, Pauley discloses an entertainment system comprising:

- a) a display monitor (12);
- b) a broadcast receiver coupled to the display monitor including:
 - (b1) a first front end unit (26) capable of receiving a first show;
 - (b2) a second front end unit (28) capable of receiving a second show;
 - (b3) a plurality of memory elements (col. 4, lines 7-39);

Art Unit: 2611

(b4) a central processing unit (50) coupled to the plurality of memory elements, wherein the central processing unit (50) selects one of the plurality of shows into the plurality of memory elements, processes each show separately and displays the plurality of shows continuously in a picture in picture format (columns 5-7).

However, Pauley fails to disclose receiving programming data associated with first and second show selections provided by first and second source selections from first and second plurality of sources displayed (respectively) as recited in the claims.

Schein discloses a multi-source information television system for receiving programming data associated with first and second show selections provided by first and second source selections from first and second plurality of sources displayed. Schein's display system allows the user to select one or more shows from multiple occurrences of the same shows from various input sources (e.g. DBS, Cable, regular broadcast etc.). The advantage is that the user can select a desired source at a desired time for a particular show.

It would have been obvious to one of ordinary skill in the art to modify Pauley's system to include receiving programming data associated with first and second show selections provided by first and second source selections from first and second plurality of sources displayed (respectively), as taught by Schein, for the advantage of enabling easy selection of desired shows at desired times from a combined list of multiple input sources.

Claims 18 and 28 are met by the combined systems of Pauley and Schein, wherein Schein discloses an integrated receiver decoder (IRD) in column 3.

Art Unit: 2611

Claims 19-20 and 29-30 are met by the combined systems of Pauley and Schein, wherein Schein discloses that coordinator (13) includes CPU (26) and memory that serve as the devices for operating the system in col. 3, line 59 - col. 4, line 63.

Considering claims 21-23 and 31-33, the combined systems of Pauley and Schein disclose an apparatus for receiving programming from plural sources such as from a satellite system, local broadcast or cable companies. However, they fail to specifically disclose first and second coding techniques and that the first and second coding techniques are amplitude modulation, frequency modulation and phase modulation as recited in the claims.

The examiner takes Official Notice that it is notoriously well known in the art to implement amplitude modulation, frequency modulation and phase modulation for transmitting programs from a central station to terminals at user locations.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combined systems of Pauley and Schein to include amplitude modulation, frequency modulation and phase modulation because these are well known transmission techniques used for broadcasting programs to viewers/subscribers.

Claims 24-25 and 34-35 are met by the combined systems of Pauley and Schein, wherein Pauley discloses the various input sources in col. 5, lines 16-18 and Schein discloses the various input sources throughout the entire reference including but not limited to col. 2, lines 25-43.

Art Unit: 2611

Claims 36-39, 41-48 are met by the combined systems of Pauley and Schein, wherein Schein discloses a monitor to display the first, second or any number of shows and a VCR (13) to concurrently record the first, second or any number of shows.

Claim 40 is met by the combined systems of Pauley and Schein, wherein Schein discloses that the broadcast receiver is the combination of one or more of cable TV box, DBS box and coordinator receiver. A cable TV or DBS box inherently contains a decryption engine for decrypting premium programs provided by content providers.

Response to Amendment

4. The amendment to the claims filed on 5/13/2002 and 8/28/2002 do not comply with the requirements of 37 CFR 1.121(c) because of the following:

a) the language “***receiving a second user-specified source selection identifying a selector source for the second user-specified show selection***” (lines 15-16) of claim 6 is not present in the mark-up copy provided by applicant on 5/13/2002.

b) A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph

Art Unit: 2611

(c)(1)(i) of this section and the marked up version under this paragraph. **Note that at least claim 6 was amended three times. Therefore, claim 6 should indicate "(thrice amended)".**

Applicant should review and revise the status of all claims in the application.

5. Amendments to the claims filed after March 1, 2001 must comply with 37 CFR 1.121(c) which states:

(c) Claims.

(1) **Amendment by rewriting, directions to cancel or add:** Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(I) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Response to Arguments

6. Applicant's arguments filed 5/13/2002 have been fully considered but they are not persuasive.

Art Unit: 2611

Response to Applicant's arguments

a) Applicant states that following on page 11 (fourth paragraph) of the amendment filed 5/13/2002:

“Paragraph 2 of the Action states

Considering claim 1, Pauley discloses....”

In response, Applicant is totally incorrect. The Office action mailed 2/12/2002 did not indicate a rejection to claim 1. Claim 1 has been canceled in response to Applicant's amendment filed 1/17/2002.

b) Applicant argues The Pauley Reference Channels vs. Sources on pages 11-13 of the amendment filed 5/13/2002.

In response, applicant should note that the Pauley reference was cited to teach the display of two shows simultaneously (i.e. picture in picture). The Examiner acknowledges that Pauley does not teach two or more sources. The two or more sources feature are taught by Schein as indicated and argued by the Examiner in the previous Office Action at pages 2 and 8-9.

c) Applicant argues Pauley and Selection of Two Sources on pages 13-14 of the amendment filed 5/13/2002.

Art Unit: 2611

(Response). Again, the Examiner acknowledges that Pauley does not teach two or more sources. The two or more sources feature are taught by Schein as indicated and argued by the Examiner in the previous Office Action at pages 2 and 8-9.

d) Applicant argues that **“However, Applicant explicitly recites showing both said first and second selections at the same time. Schein does not teach this”** on page 14, line 14-16 of the amendment filed 5/13/2002.

In response, Applicant should note that the Schein reference was cited to teach the various “receiving a user’s show selection” and the “user’s source selections” limitations of claims 6, 16, 26, 41 and 46 as indicated in the previous Office Action. The Pauley reference was cited to teach the “concurrent display of two programs” or “continuous display of two programs” on one screen (i.e. picture-in-picture).

e) Applicant argues **“column 6, lines 39-52”** (line 1) and that **“This is only a single selection. There are not two selections”** (line 25) of the Schein reference at page 15 of the amendment.

(Response) First, the Examiner suggests that Applicant refer back to the Examiner’s arguments at paragraph b), pages 9-10 in the Office Action mailed 2/12/2002.

Secondly, the Schein reference refers to selecting a plurality of shows from plural sources. The Schein reference indicates selecting a first show (“GONE WITH THE WIND) from plural

Art Unit: 2611

sources as an example. However, note the following selection of plural shows from plural sources:

- a) a first show "GONE WITH THE WIND" from plural sources (figure 2);
- b) a second show "CASABLANCA" from plural sources (figure 2);
- c) a third show "BATMAN" from plural sources (figure 2);
- d) a fourth show "SOAP" from plural sources (figure 2); and
- e) a fifth show "COSBY SHOW" from plural sources (column 5, last line).

Therefore, Schein discloses selecting one or more shows from plural sources.

Thirdly, the simultaneous selections of shows are taught by Pauley and not by Schein. Therefore, since Pauley discloses the picture-in-picture feature and Schein teaches selecting programs via sources, the Examiner contends that the combined systems of Pauley and Schein meet the claimed limitations and applicant's arguments are not persuasive.

f) Applicant argues the Pauley and Schein reference individually.

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Art Unit: 2611

g) Applicant states that “**Claims 6-48 relate particular to picture in picture display from different sources, processing data from different sources and methods thereof**” on page 11, second paragraph of the amendment filed 5/13/2002.

(Response) The Examiner posits that the combined systems of Pauley and Schein relate particular to picture in picture display from different sources, processing data from different sources and methods thereof. Again, Pauley teaches “picture-in-picture” and Schein teaches “selecting two or more programs from different sources”. Since sufficient motivation to combine the references is provided at page 4 above, the Examiner posits that Applicant’s arguments are not persuasive.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2611

Conclusion

8. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

(703) 872-9314 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306 0377.



Christopher Grant
Primary Examiner
November 8, 2002